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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/607,057	06/27/2003	Anthony A.J. De Graaff	0142-0411P	4155
2292 7590 03/17/2008 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
EXAMINER ZHENG, JACKY X				
ART UNIT 2625		PAPER NUMBER		
NOTIFICATION DATE 03/17/2008		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

**Advisory Action
Before the Filing of an Appeal Brief**

Application No. 10/607,057	Applicant(s) DE GRAAFF ET AL.
Examiner JACKY X. ZHENG	Art Unit 2625

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 21 February 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
 Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: _____.
 Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
 13. ☐ Other: _____.

/Twyler L. Haskins/
 Supervisory Patent Examiner, Art Unit 2625

Continuation of 11, does NOT place the application in condition for allowance because:

the argument presented by Applicant are respectfully found to be unpersuasive with respect to the outstanding issues, such as the prior art rejection under 35 USC 103. As various issues relating to the claim rejections set forth in the office action mailed on August 24, 2007 have not yet been resolved, and the claims have also not been amended for overcoming the issues, Examiner respectfully submits that merely the arguments presented (after Final Rejection) not yet placing the application in condition for allowance, the grounds of rejection are thus maintained for reasons of record.

Responses to Arguments

With respect to Applicant's remarks on Page 2 (the "Remarks" filed on February 22, 2008), asserting the Office Action is "confusing at best, and probably in error" . Applicant's arguments are carefully and fully considered, however found to be not persuasive at all. Specifically, first, with respect to making assertions of Office Action being confusing after prosecution is officially closed, whereas if Applicant had indicated an *extra* detailed form of discussions is desired at early stage of prosecution (such upon the amendment after non-final rejection) due to a different level of skills, then more details discussions could have been provided by Examiner in Final Rejection as requested by courtesy (considering the discussion of prior art rejection of record is already in a detailed form). Second, considering the fact that the grounds of rejection in non-final rejection and ones later set forth in the final rejection are substantially similar, further if Applicant was able to formulate a complete reply on basis of the similar rejection then (as by filing of a reply dated on June 11, 2007) with no indication of the rejection being "confusing and etc." then, it is unpersuasive to present such an argument of the office action being "confusing and etc." all the sudden after final rejection (after prosecution is closed) considering the grounds of rejection are substantially similar. Further, with respect to Applicant's interpretation of number of references, Examiner respectfully submits that the rejection is, clearly as indicated, relied on total of four references (as indicated in Paragraph 11 of Final Rejection), and "*EP0589724 (Published on March 30, 1994, hereinafter as "Searby") with Applicant's admitted prior art*" as indicated in the ground of rejection is merely indicating the reference, EP 0589724, which is the primary reference to be relied on, and also evidenced by Applicant's admission of disclosure and/or teachings of claimed limitations in EP 058724 (as in

the discussion was followed in next paragraph in Final Rejection). Arguments of such after prosecution is closed (being finally rejected) and further seeking of "a new and non-final rejection"(as indicated) is deemed to be not persuasive.

With respect to Applicant's arguments, i.e. second paragraph of page 4 of "Remarks", asserts "*However, in Applicants' invention, as noted in paragraph 010 of Applicants' originally filed specification, a preview image is extracted **from a stream of data**, and written to a thumbnail file. Thus, a small file may be quickly made available. Even though it is a small file, the preview image is representative of an entire area of a scanned image. Because the preview file is **created directly from the stream of data**, it is available directly after, or even before the scanning is finished. Thus, the preview file can be used for a quick check of the scanning process without requiring processing of large amounts of data comprised in the master file*"; and second paragraph of page 5 in "Remarks", further asserts "*However, Searby does not disclose or suggest Applicants' claimed thumbnail file. Indeed, the Official Action provides no citation for Applicants' claimed thumbnail file. Furthermore, Searby does not disclose or suggest a controller that is configured to extract data encoding the preview image **from the stream of data** that is written to a master file. That is, there is no extraction **directly from a stream**. Because Searby does not disclose or suggest extracting data from a stream of data, Searby also fails to disclose or suggest writing any corresponding extracted data to any file, let alone to Applicants' claimed thumbnail file*". Arguments are again carefully and fully considered, however found to be not persuasive. In response to Applicant's arguments, Examiner respectfully submits that though claims are interpreted in light of the specification, however limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Applicant is reminded that in order for such limitations to be considered, the claim languages require to *specifically* recite such limitations in the claim, otherwise *broadest reasonable* interpretations of the broadly claimed limitations are deemed to be proper.

Finally, with respect to Applicant's argument regarding "thumbnail file", as a response has already been set forth in the final rejection dated August 24, 2007, in paragraph 8, will also reproduced as below as the response to such similar argument.

"8. In re Applicant's remarks on Page 6, 1st paragraphs to 3rd paragraph, regarding the rejection made under 35 U.S.C. §103(a) with regard to claim 1 (and identically claims 6 and 17 as indicated by Applicant), Applicant asserts that Searby "*does not disclose the features of the controller is further configured to extract data encoding the preview*

image from the stream of data, and to write the extracted data to a thumbnail file”; and further asserts “*Applicants’ disclosed related prior art provided on pages 1 and 2 of the specification does not disclose extracting data encoding the preview image and writing the extracted data to a thumbnail file*”. Applicants’ arguments are fully considered by Examiner, however found to be unpersuasive for at least the following reasons. In consideration of Paragraph [005] of the specification, Applicants’ admitted that the disclosure of the cited prior art, the limitations of “an initial high-resolution image is held in a high capacity storing unit. The system comprises a small capacity high speed storing unit and is arranged to transfer portions of the initial high-resolution image to the small capacity high speed storing unit a portion at a time, ... image data is down converted (“a preview view image with lower size data”) and written to a destination area (“a thumbnail file”) for output to the viewing store”. Additionally, in consideration of the broad usages of claim language, insufficient descriptions in the claim languages, and lack of *explicit and deliberate* definition provided in the specification with regard to the limitation of “thumbnail file”, a memory for storing (or to be written to) a “down converted” image data will be an reasonable interpretation of such a broad claim limitation. For at least the reasons set forth above, the rejection made under 35 U.S.C. §103(a) over EP 0589724 (Published on March 30, 1994, hereinafter refer as “Searby”) with Applicant’s admitted prior art (Application No. 10/607,057) and further in views of Patton et al. (U.S. 6,795,209), Zhou (U.S. Pub. No. 2002/0015447) and Baggs et al. (U.S. Pub. No. 2003/0231801), with regard claim 1 is maintained. ”

In conclusion, for at least the reasons set forth previously and ones set forth above, the rejection made under 35 U.S.C. 103(a) over the prior arts of record is maintained as Applicant failed to further point to the deficiency of the rejection (i.e. a claimed limitation over the prior art).